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Practitioner's Docket No. U 011098-6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re prior application of: Oscar Johannes Maria GODDIJN et al.
Application No.: 08/779,460 Group No. 1638
Filed: January 7, 1997 Examiner: D. Fox

For: ENHANCED ACCUMULATION OF TREHALOSE IN PLANTS

NOTE: "In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability: (i) Title of invention; (ii) Name of applicant(s); and (iii) Correspondence address." 37 C.F.R. Section 1.53(d)(8).

Box CPA
Assistant Commissioner for Patents
Washington, D.C. 20231

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PATENT TRADEMARK OFFICE

CONTINUED PROSECUTION APPLICATION (CPA)
(37 C.F.R. SECTION 1.53(d))

WARNING: CPA practice does **not** apply (other than designs) where the prior application has a filing or CPA date on or after May 29, 2000.

NOTE: A continued prosecution application can only be used to file a divisional or continuation of a prior nonprovisional application and can **NOT** be used to file a continuation-in-part application. 37 C.F.R. Section 1.53(d)(1).

CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) AND 1.10*
(When using Express Mail, the Express Mail label number is **mandatory**;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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☒ deposited with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

37 C.F.R. Section 1.8(a)

37 C.F.R. Section 1.10*

☐ with sufficient postage as first class mail.

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☐ facsimile transmitted to the Patent and Trademark Office (703) _____

Date: APRIL 6, 2001

Maria Melian
Signature

MARIA MELIAN

(type or print name of person certifying)

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(Continued Prosecution Application (CPA))--page 1 of 12) 4-2

WARNING: While facsimile transmission can be used to obtain a date of transmission for this correspondence the date on the certificate of transmission (Section 1.8(a)) of an application under Section 1.53(d) (CPA) is not controlling (or even relevant), in that a CPA filed by facsimile transmission will not be accorded a filing date as of the date on the certificate of transmission (Section 1.8(a)) unless Office records indicate, or applicant otherwise establishes pursuant to Section 1.6(f), receipt in the Office of the complete application under Section 1.53(d) on the date on the certificate of transmission, and that date is not a Saturday, Sunday, or Federal holiday.. 37 C.F.R. Section 1.8(b)(3) and 62 Fed. Reg. 53131, 53133, October 10, 1997. Requests for a continued prosecution application filed by facsimile transmission should be clearly marked "Box CPA". 37 C.F.R. Section 1.53(d)(9).

Before using the CPA procedure note that a CPA application (Section 1.53(d)) cannot be amended to delete the specific reference to a prior application (e.g., for patent term purposes), as well as the specific reference to any application to which the prior application contains a specific reference under 35 U.S.C. Section 120, 121 and 365(c) and the expiration date under 35 U.S.C. Section 154(b)(2) of any patent issuing from the Section 1.53(d) application will be based upon the filing date of the prior application (or the earliest application to which the prior application contains a reference under 35 U.S.C. Section 120, 121, and 365(c)). 62 Fed. Reg. 53,131, 53,145, October 10, 1997.

WARNING: A continued prosecution application "Is a request to expressly abandon the prior application" as of its filing date. 37 C.F.R. Section 1.53(d)(2)(v). Therefore, where the prior application is not to be abandoned, any continuation or divisional application must be filed under 37 C.F.R. Section 1.53(b).

WARNING: While the filing of a continued prosecution application is the specific reference required by 35 U.S.C. Section 120 to every application assigned the application number identified in such request, no amendment in the application may delete the specific reference to any prior application (e.g., for patent term purposes). 37 C.F.R. Section 1.53(d)(7).

WARNING: A request for an application under Section 1.53(d) (CPA) cannot be submitted within papers filed for another purpose (e.g., the filing of a "conditional" request for a continued prosecution application within an amendment after final for the prior application). A "conditional" request for a CPA submitted (as a separate paper) with an amendment after final will be treated as an unconditional request for a CPA. This will result (Section 1.53(d)(2)(v)) in the abandonment of such prior application, and (if so instructed in the request for CPA) the amendment after final in the prior application will be treated as a preliminary amendment in the CPA. 62 Fed. Reg. 53,131, 53,140, October 10, 1997.

NOTE: "The filing date of a continued prosecution application is the date on which a request on a **separate** paper for an application...is filled." 37 C.F.R. Section 1.53(d)(2)(emphasis added).

1. This is a request for a filing of a
[X] continuation
[] divisional

continued prosecution application under 37 C.F.R. Section 1.53(d) of the above identified prior nonprovisional application.

WARNING: "A request for a CPA expressly abandons the prior application as of the filing date of the request for the CPA. See 37 C.F.R. Section 1.53(d)(2)(v). Therefore, where the prior application is not to be abandoned, any continuation or divisional application must be filed under 37 C.F.R. Section 1.53(b)." M.P.E.P. Section 201.06(d), 7th ed.

It is further requested that this continued prosecution application utilize the file jacket and contents of the prior application, including the specification, drawings and oath or declaration from the prior application, to constitute this new application, and that the application number of the above identified prior application be assigned for identification purposes. 37 C.F.R. Section 1.53(d)(2)(iv).

NOTE: Since a CPA cannot contain new matter, the oath or declaration filed in the prior nonprovisional application would supply all the information required under 35 U.S.C. Section 111(a) and the rules to have a complete application and to obtain a filing date. Accordingly, the previously filed oath or declaration will be considered to be the oath or declaration of the CPA. M.P.E.P. Section 201.06(d), 7th ed.

It is also requested that the above-identified prior application be expressly abandoned as of the filing date accorded this continued prosecution application. 37 C.F.R. Section 1.53(d)(2)(v).

2. With respect to the above-identified prior nonprovisional application this continued prosecution application is being filed:

- A. ☒ before the earliest of the:
- ☒ termination of the proceedings on the prior application. 37 C.F.R. Section 1.53(d)(1)(ii)(C).
 - ☒ payment of the issue fee on the prior application. 37 C.F.R. Section 1.53(d)(1)(ii)(A).
 - ☒ abandonment of the prior application. 37 C.F.R. Section 1.53(d)(1)(ii)(B).

OR

- B. ☐ after the payment of the issue fee but a petition under Section 1.313(b)(5) has been granted in the prior application. 37 C.F.R. Section 1.53(d)(1)(ii)(A).

NOTE: "If an extension of time is necessary to establish continuity between the prior application and the CPA, the petition for extension of time should be filed as a separate paper directed to the prior nonprovisional application. However, a CPA is not improper simply because the request for a CPA is combined in a single paper with a petition for extension of time. . . .

"While the filing of a CPA is not strictly a reply to an Office action mailed in a prior application, a request for a CPA is a paper directed to and placed in the file of the prior application, and seeks to take action in (i.e., expressly abandon) the prior application. Thus, it will be considered a "reply" for purposes of 37 C.F.R. Section 1.136(a)(3). As a result, an authorization in the prior application to charge all required fees, fees under 37 C.F.R. Section 1.17, or all required extension of time fees to a deposit account will be treated as a constructive petition for an extension of time in the prior application for the purposes of establishing continuity with the CPA. The correct extension fee to be charged in the prior application would be the extension fee necessary to establish continuity between the prior application and the CPA on the filing date of the CPA.

"If an extension of time directed to the prior application is filed as a separate paper, it must be accompanied by its own certificate of mailing under 37 C.F.R. Section 1.8 (if mailed by first class mail) or under 37 C.F.R. Section 1.10 (if mailed by Express Mail), of the benefits of those rules are desired."

M.P.E.P. Section 201.06(d), 7th ed.

C. The term for response or taking action in the prior application expires on FEBRUARY 6, 2001.

[X] An extension of time in the prior application is:

[X] filed concurrently by the next entry below in the prior application

[] has been filed on _____.

[X] Applicant petitions for an extension of time under 37 C.F.R. 1.136(a)
(fees: 37 C.F.R. 1.17(a)(1)-(4)) for the total number of months checked below:

	Extension (months)	Fee for other than <u>small entity</u>	Fee for <u>small entity</u>
[]	one month	\$ 110.00	\$ 55.00
[X]	two months	\$ 390.00	\$ 195.00
[]	three months	\$ 890.00	\$ 445.00
[]	four months	\$ 1,390.00	\$ 695.00

Fee: \$ 390.00

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for _____ months has already been secured. The fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

OR

☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

3. It is noted that:

- * This application discloses and claims only subject matter disclosed in the prior application. 37 C.F.R. Section 1.53(d)(2)(ii).
- * Filing of this continued prosecution application is to be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. Section 122 to the extent that any member of the public, who is entitled under the provisions of Section 1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of 37 C.F.R. Section 1.53(d), may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket. 37 C.F.R. Section 1.53(d)(6).
- * Filing of this request is the specific reference required by 35 U.S.C. Section 120 to every application assigned the application number identified in this request and that no amendment in this application may delete this specific reference to any prior application. 37 C.F.R. Sections 1.53(d)(7) and 1.78(a)(2).

4. This continued prosecution application names as inventors:

- ☒ the same inventors named in the prior application on the date this continued prosecution application under 37 C.F.R. Section 1.53(d)(2)(iii) is being filed.
- ☐ fewer than all the inventors named in the prior application. 37 C.F.R. Section 1.53(d)(4).

NOTE: A CPA application may be filed by fewer than all the inventors named in the prior application, provided the request for an application under 37 C.F.R. Section 1.53(d), when filed, is accompanied by a statement requesting deletion of the name(s) of the person(s) who are not the inventors of the invention being claimed in the new application. 37 C.F.R. Section (d)(4).

- ☐ please delete the following name(s) as inventor(s), who are not inventor(s) of the invention being claimed in this new application:

NOTE: "No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of a petition under Section 1.48." 37 C.F.R. Section 1.53(d)(4).

NOTE: A request for an application under Section 1.53(d) purporting to name as an inventor a person not named as an inventor in the prior application (even if accompanied by a new declaration/oath under Section 1.63 listing that person as an inventor) will be treated as naming the same inventors named in the prior application (Section 1.53(d)(2)(iii)). 62 Fed. Reg. 53,131, 53,141, October 10, 1997.

- ☐ Please add the following name(s) as inventors:

- ☐ A petition under Section 1.48 is attached.

5. ☐ An amendment to the prior application as it existed prior to the filing of this continuation prosecution application is ☐ attached
☐ not attached
- ☐ Please enter in this CPA application the unentered amendment under 37 C.F.R. Section 1.116 filed in the prior application.

NOTE: "Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with Section 1.125." However, the applicant must comply with the requirements of 37 C.F.R. Section 1.125(b) before the substitute specification will be entered into the CPA. 37 C.F.R. Section 1.53(d)(5).

WARNING: *"The original disclosure of a CPA is the same as the original disclosure of the parent non-continued prosecution application and amendments entered in the parent application(s). However, any subject matter added by amendment in the parent application which is deemed to be new matter in the parent application will also be considered new matter in the CPA. No amendment filed in a CPA, even if filed on the filing date of the CPA, may include new matter." M.P.E.P. Section 201.06(d), 7th ed.*

NOTE: All information disclosure statements filed in the prior application that comply with the content requirements of 37 C.F.R. Section 1.98 will be considered in a CPA by the examiner. No specific request that the previously submitted information be considered in a CPA is required.

[] Enclosed is an Information Disclosure Statement in accordance with the requirements of 37 C.F.R. Section 1.98.

Calculation

NOTE: "(3) The filing fee for a continued prosecution application filed under this paragraph is:

(i) The basic filing fee as set forth in Section 1.16; and

(ii) Any additional Section 1.16 fee due based on the number of claims remaining in the application after entry of any amendment accompanying the request for an application under this paragraph and entry of any amendments under Section 1.116 unentered in the prior application which applicant has requested to be entered in the continued prosecution application."

37 C.F.R. Section 1.53(d)(3)(i) and (ii).

A. ☒ Regular application

CLAIMS AS FILED

Claims	Number Filed	Basic Fee Allowance	Number Extra	Rate	Basic Fee 37 C.F.R. Section 1.16(a) \$710.00
Total Claims (37 C.F.R. Section 1.16(c))	- 20 =		x	\$ 18.00	
Independent Claims (37 C.F.R. Section 1.16(b))	- 3 =		x	\$ 80.00	
Multiple Dependent Claim(s), if any (37 C.F.R. Section 1.16(d))			+	\$270.00	

- ☐ Amendment canceling extra claims is enclosed.
☐ Amendment deleting multiple-dependencies is enclosed.
☐ Fee for extra claims is not being paid at this time.

NOTE: If the fees for extra claims are not paid on filing they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 C.F.R. Section 1.16(d).

Filing Fee Calculation \$ 710.00

B. ☐ Design application
(\$320.00--37 C.F.R. Section 1.16(f))
Filing Fee Calculation \$ _____

C. ☐ Plant application
(\$490.00--37 C.F.R. Section 1.16(g))
Filing Fee Calculation \$ _____

8. Small Entity Statement(s)

WARNING: *Small entity status must not be established unless the person(s) signing the statement can **unequivocally** make the required self-certification. M.P.E.P. Section 509.03, 6th ed., rev. 2, July 1996. (emphasis added).*

☐ Statement(s) that this is a filing by a small entity under 37 C.F.R. Sections 1.9 and 1.27 is (are) attached.

WARNING: *"... Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. The refiling of an application under Section 1.53 as a continuation, division, or continuation-in-part (including a continued prosecution application under Section 1.53(d)), or the filing of a reissue application **requires a new determination as to continued entitlement to small entity status for the continuing or reissue application.** A nonprovisional application claiming benefit under 35 U.S.C. Section 119(e), 120, 121, or 365(c) of a prior application, or a reissue application may rely on a statement filed in the prior application or in the patent if the nonprovisional application or the reissue application includes a reference to the statement in the prior application or in the patent or includes a copy of the statement in the prior application or in the patent and status as a small entity is still proper and desired. The payments of the small entity basis statutory filing fee will be treated as such a reference. . . ." 37 C.F.R. Section 1.28(a)(2), (emphasis added).*

WARNING: *"Small entity status must not be established when the person or persons signing the . . . statement can **unequivocally** make the required self-certification." M.P.E.P., Section 509.03 7th ed., (emphasis added).*

(complete the following, if applicable)

☐ Status as a small entity was claimed in prior application _____, filed on _____, from which benefit is being claimed for this application under:

35 U.S.C. Section ☐ 119(e) - provisional,
 ☐ 120 - continuation,
 ☐ 121 - divisional,
 ☐ 365(c) - PCT,

and which status as a small entity is still proper and desired.

☐ A copy of the statement in the prior application is included.

Filing Fee Calculation (50% of A, B or C above)

Filing Fee Calculation \$ _____

NOTE: *Any excess of the full fee paid will be refunded if a small entity statement and a refund request are filed within 2*

months of the date of timely payment of a full fee. The two-month period is not extendable under Section 1.136. 37 C.F.R. Section 1.28(a).

9. Fee Payment Being Made at This Time

☒ Not Enclosed

☒ No filing fee is to be paid at this time. Applicant hereby revokes any general authorization to pay fees filed in the prior non-provisional application of which this is a CPA.

Applicant hereby revokes any general authorization to pay fees filed in the prior non provisional application of which this is a CPA.

NOTE: Since a general authorization to charge fees to a deposit account in the prior nonprovisional application carries over to the CPA, where the applicant desires to file the CPA without paying the filing fee on the filing date of the application, the applicant may file the CPA with specific instructions revoking the general authorization filed in the prior application. M.P.E.P. Section 201.06(d), 7th ed.

(This and the surcharge required by 37 C.F.R. Section 1.16(e) can be paid subsequently.)

☐ Enclosed

NOTE: An applicant filing a CPA by facsimile must include an authorization to charge the basic filing fee to a deposit account, or the application will be treated under 37 C.F.R. Section 1.53(f) as having been filed without the basic filing fee (as fees cannot otherwise be transmitted by facsimile. M.P.E.P. Section 201.06(d), 7th ed.

NOTE: A general authorization to charge fees to a deposit account filed in the prior nonprovisional application carries over to a CPA and, in such a situation, the necessary filing fee will be charged to the deposit account. M.P.E.P. Section 201.06(d), 7th ed.

☐ Filing fee \$ _____

NOTE: Payment of a small entity basic filing fee will be treated as a reference to the statements in the prior application that status as a small entity is desired and proper. 37 C.F.R. Section 1.28(a)(2).

☐ Recording assignment
(\$40.00; 37 C.F.R. Section 1.21(h))
(See attached "COVER SHEET FOR ASSIGNMENT
ACCOMPANYING NEW APPLICATION.") \$ _____

☐ Petition fee for filing by other than all the
inventors or person on behalf of the inventor
where inventor refused to sign or cannot be reached
(\$130.00; 37 C.F.R. Section 1.47 and 1.17(i)) \$ _____

Total filing fees enclosed \$ _____

TOTAL FEE DUE

The total fee due is:

Filing Fee \$ _____
Extension fee (if any) \$ 390.00
TOTAL FEE DUE \$ 390.00

10. Method of Payment of Fees

- ☒ Check in the amount of \$ 390.00.
☐ Charge Account No. _____ in the amount of \$ _____.
A duplicate of this transmittal is attached.

NOTE: Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 C.F.R. Section 1.22(b).

WARNING: Unless an application under Section 1.53(d) filed by facsimile includes an authorization to charge the basic filing fee to a deposit account, the applicant will be given a notification requiring payment of the appropriate filing fee (Section 1.53(d)(3)) and the late filing surcharge under Section 1.16(e) to avoid abandonment of the Section 1.53(d) application. 62 Fed. Reg. 53,131, 53,133 (Oct. 10, 1997).

11. Authorization to Charge Additional Fees

WARNING: If no fees are to be paid on filing, the following items should not be completed.

WARNING : Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges, if extra claim charges are authorized.

- ☐ The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Account No. 12-0425.
- ☐ 37 C.F.R. Section 1.16(a), (f) or (g) (filing fees)
- ☐ 37 C.F.R. Section 1.16(b), (c) and (d) (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 C.F.R. Section 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

- ☐ 37 C.F.R. Section 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)
- ☐ 37 C.F.R. Section 1.17(a)(1)-(5) (extension fees pursuant to Section 1.136(a))
- ☐ 37 C.F.R. Section 1.17 (application processing fees)

WARNING:

"A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under Section 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in Section 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission." 37 C.F.R. Section 1.136(a)(3).

☐ 37 C.F.R. Section 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. Section 1.311(b))

NOTE: *Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 C.F.R. Section 1.311(b).*

NOTE: *37 C.F.R. Section 1.28(b) requires "Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying, . . . issue fee." From the wording of 37 C.F.R. Section 1.28(b), (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.*

12. Instructions as to Overpayment

NOTE: *"Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 C.F.R. Section 1.26(a).*

☒ Credit Account No. 12-0425

☐ Refund

13. Change of Correspondence Address Since Filing of Parent Application

NOTE: *"Special care should be taken in continuation or divisional applications to ensure that any change of correspondence address in a prior application is reflected in the continuation or divisional application. For example, where a copy of the oath or declaration from the prior application is submitted for a continuation or divisional application filed under 37 CFR 1.53(b) and the copy of the oath or declaration from the prior application designates an old correspondence address, the Office may not recognize, in the continuation or divisional application, the change of correspondence address made during the prosecution of the prior application. Applicant is required to identify the change of correspondence address in the continuation or divisional application to ensure that communications from the Office are mailed to the current correspondence address. 37 CFR 1.63(d)(4)." Section 601.03, M.P.E.P., 7th Edition.*

(complete the following if applicable)

Since this filing is a ☐ continuation ☐ divisional there is attached hereto a Change of Correspondence Address so that there will be no question as to where the PTO should direct all correspondence.

Note: *An attorney acting under Section 1.34(a) may expressly abandon an application as of the filing date granted to a continuing application thereof when filing such a continuing application. See Section 711, M.P.E.P., 7th Edition.*

Date: April 6, 2001

Reg. No. 30,086

Tel. No.: (212) 708-1890

Customer No.:



SIGNATURE OF PRACTITIONER

Clifford J. Mass

(type or print name of practitioner)

P.O. Address

c/o Ladas & Parry
26 West 61st Street
New York, N.Y. 10023